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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Manish Upendran

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EXAMINER

GRAHAM, PAUL J

ART UNIT

PAPER NUMBER

2623

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/752,739	<b>Applicant(s)</b> UPENDRAN ET AL.	
	<b>Examiner</b> PAUL J. GRAHAM	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 10,20 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9,11-19,21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/1/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/1/08 has been entered.

### ***Information Disclosure Statement***

2. The references listed on the Information Disclosure statements filed 7/1/08 have been considered by examiner (see attached PTO-1449).

### ***Response to Arguments***

3. Applicant Argues:

*Prior Art relates to a different architecture.*

The Examiner respectfully disagrees. In fact, the prior art espouses architecture similar if not the same as that of the instant application, a network with bi-directional potential and uni-directional potential. The argument that the prior art does not teach bidirectional and unidirectional communication is just simply incorrect. It is to be noted that the two are not mutually exclusive; a bi-directional communication *is* a system of uni-directional communications. The Houghton reference uses a Web-TV architecture (or a “web-based

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TV system” as noted by the inventor) (see Houghton, col. 2, ll. 15-50), this network includes bi-directional communication, including the internet and uni-directional communication in form of TV broadcasting (which is not strictly uni-directional if feedback is available, which it is, note channel tuning and other responses per STB, see Houghton, fig. 7 shows a bi-directional link between broadcast center (TV provider) and user).

*With respect to the argument that the STB is a one-way directional device.* This has already been answered as by the Applicant’s representatives in Remarks 6/30/08, p. 13: there it reads that the prior art is bi-directional. If applicant is arguing that the network is bi-directional, how can the STB, which is part of the network and participates in the network, not be a bi-directional interface—it cannot. That is, the STB, a specific purpose computer (making this a *user’s computer*)(see Houghton, col. 2, ll. 15-50) that participates in *interactive* content (see Houghton, col. 7, l. 65-col. 8, l. 35), that is noted by the Applicant's representatives in Remarks 7/1/08, p. 14 as such, is inherently an interactive and therefore, bi-directional interface, it receives content and transmits content. It has therefore been unequivocally shown that the “architecture” of the prior art is the same as that of the instant application.

*Houghton is directed to solely receiving content*

The Examiner respectfully disagrees. Again, by its very nature, the bi-directional nature of the network, denotes that the user device in Houghton allows for entering preferences, transmitting those preferences and receiving contents in accordance. This reads squarely on the description of an EPG (which is an integral part of the Houghton system), where a

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user views content (an EPG listing), enters preferences (selects a channel), the selection is transmitted and the user is able to view the content selected (the contents in accordance are received) (see Houghton, col. 2, l. 55-col. 3, l. 28).

*With respect to the argument that Houghton does not teach overlays selected by a user from a list of overlays prior to display.* This is inaccurate; of course, Houghton teaches selection of overlays (see Houghton, col. 5, ll. 1-10, which also notes the bi-directional nature of the Houghton interface, it requests a URL (definitely, the request goes upstream to provider) and then the user receives content (definitely, the response goes downstream to user)--the epitome of bi-directional); the overlays are selected from a list of overlays (note Houghton, col. 7, l. 65-col. 8, l. 35, fig. 8 and 9 show overlaid links and windows on a backdrop, these overlays including URLs are listed for user selection, once selected, they result in further display of an overlay, also as noted, the user may choose the URLs displayed (from a listing, otherwise only a single URL would be available for choosing) for future choosing of overlays to display); and the choice of overlays (URLs, hotlinks, Windows) is made prior to display by the user-that is the nature of the featured tuning).

*With respect to the argument that Hassell does not teach a prior selection of an overlay from a listing of overlay data that is presented in conjunction with programming.* Hassell does show a list of overlay data that is presented for selection prior to display of overlay data that is presented in conjunction with the programming. Hassell shows a listing of overlay data in black space (selections 9.1-9.4) on a display screen, which is selectable in order to spawn or generate a window of overlay data (such as the "US Weather Map"),

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this selection is necessarily done prior to the display of the US Weather Map (see Hassell, [95-97], fig. 7).

The Applicants arguments have been fully considered and are not persuasive. Claims 1-9, 11-19, 21-29 stand rejected.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 currently amended recites "... overlays selected by a user from a list of overlays prior to being displayed in conjunction with said broadcast programming content." It is noted that if overlays are *associated* with programming content (which has been established), they are in *conjunction* with said content. This is an unnecessary redundancy. It is not supported that overlays are selected from list prior to being *displayed*. In the instant specification (see instant spec [66] and fig. 5f) it is noted that the overlays are displayed. Given that the overlays are already displayed in the listing for

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selection, the overlays cannot be selected prior to being displayed. Hence, there is not only no support in the specification for this claim limitation, it also runs counter to what is stated in the specification.

Claim 1 currently amended reads "...a user computer, coupled to a bi-directional communication data network,...". This recitation of a bi-directional data network is not supported in the specification. There is no instance in the originally filed specification that denotes a "*bi-directional*" data communication network (let alone a "*uni-directional*" data communication"). Additionally, the element referred to as communication data network (i.e., element 120 in figure 1a, b, c, 4b) is a non-descript, amorphous cloud, showing **NO** internal direction, let alone communication direction in two directions.

Claim 10 as last recited claimed dependence on claim 9, which is now cancelled.

Therefore there is no antecedent basis for the dependence of claim 10. Claim 10 was listed (without text) in the last Amendments to the Claims listing (7/1/08) as in original form.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 8-9, 11-12, 18-19, 21-22, 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Houghton et al. (US 6 757 707 B1).

As to claim 1, Houghton discloses a system comprising:

a user computer, coupled to a bi-directional communication data network, to display a user interface usable to enter a plurality of specialized content preferences and transmit said plurality of user preferences to said data network across the bi-directional communication data network (see Houghton, col. 2, ll. 15-25 for user computer; see fig. 7 for data network, see col. 6, ll. 35-42 for user interface (“featured tuning” on monitor) and figs. 8/9 and col. 9, ll. 15-21 user may select specialized content through preferences of TV channel or URLs selected, and col. 5, ll. 15-28 for specialized content such as information feeds, given that Yahoo provided EPG (see Houghton, fig. 5) is manipulated as to include selecting a subset of channels to view listing (see Houghton, col. 2, l. 55-col. 3, l. 10, such user preferences are transmitted to said network as well as EPG from cable TV providers (given that such cable network is interactive and “bi-directional”) In fact, the prior art espouses architecture similar if not the same as that of the instant application, a network with bi-directional potential and uni-directional potential. The argument that the prior art does not teach bidirectional and unidirectional communication is just simply incorrect. It is to be noted that the two are not mutually exclusive; a bi-directional communication *is* a system of uni-directional communications. The Houghton reference uses a Web-TV architecture (or a “web-based TV system” as noted by the inventor) (see Houghton, col. 2, ll. 15-50), this network includes bi-directional



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communication, including the internet and uni-directional communication in form of TV broadcasting (which is not strictly uni-directional if feedback is available, which it is, note channel tuning and other responses per STB, see Houghton, fig. 7 shows a bi-directional link between broadcast center (TV provider) and user).

*With respect to the argument that the STB is a one-way directional device.* This has already been answered as by the Applicant's representatives in Remarks 6/30/08, p. 13: there it reads that the prior art is bi-directional. If applicant is arguing that the network is bi-directional, how can the STB, which is part of the network and participates in the network, not be a bi-directional interface—it cannot. That is, the STB, a specific purpose computer (making this a *user's computer*)(see Houghton, col. 2, ll. 15-50) that participates in *interactive* content (see Houghton, col. 7, l. 65-col. 8, l. 35), that is noted by the Applicant's representatives in Remarks 7/1/08, p. 14 as such, is inherently an interactive and therefore, bi-directional interface, it receives content and transmits content. It has therefore been unequivocally shown that the “architecture” of the prior art is the same as that of the instant application);

and a server coupled to the data network to receive said plurality of user preferences from said user computer and to generate non-broadcast content based on said plurality of user preferences (see Houghton, fig. 7 for server (host computer), see col. 8, ll. 55-61 for plural user preferences (channel lineup and other user specified preferences) preferences used by host to transmit content to user);

and a broadcast-based client-side device, coupled to the a uni-directional communication network, to receive broadcast programming content from a broadcast source via the uni-directional communication data network, and to receive non-broadcast content from said server

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via the bi-directional communication network, said broadcast-based client-side device to include (see Houghton, col. 2, ll. 15-25 for STB as client-side device and col. 9, ll. 1-9 for content (both broadcast and non broadcast) through STB based on preferences, given that the broadcast network is bi-directional, it is certainly uni-directional, note that broadcast programming is received via a TV provider on a "uni-directional" network, see Houghton, fig. 7 and non-broadcast content from Internet with server (fig. 7), see Houghton, col. 2, l. 50-col. 3, l. 30-WebTV system), receive a user request to view said non-broadcast content (see Houghton, col. 3, ll. 40-46, user request is URL input); and display said non-broadcast content and said broadcast programming content on a display of said broadcast-based client-side device, wherein said non-broadcast content is displayed in accordance with said plurality of user preferences (see Houghton, col. 2, ll. 1-30, Houghton, col. 7, ll. 27-44, non-broadcast content such as hot-links or URLs are displayed, user preferences aid the display of the complementary data (channels or URLs), col. 8, ll. 52-59), and includes overlay data to display one or more overlays on said display in conjunction with said broadcast programming content, said one or more overlays selected by a user from a list of overlays prior to being displayed in conjunction with said broadcast programming content (see Houghton, col. 5, ll. 12-17 & 23-26, information available to user is augmented with related offerings such as feeds, tickers, text chat, advertisements, or text, graphics, images, virtual worlds, sounds and movies (see Houghton, col. 2, ll. 3-6, as defined in applicant' s specification, [0076]), the overlays (see Houghton, col. 7, ll. 25-28) are shown in the PIP and background regions as well as a main image on the screen (see Houghton, fig. 8), the overlays are displayed

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in conjunction with the programming content (see Houghton, col. 7, ll. 50-59, a movie channel will have complementary data such as movie listings, movie-related web pages or advertisements), the overlays are chosen by a user from a list of overlays (see Houghton, col. 8, ll. 46-48, user selects a URL *feed* from a list on a content page such as shown in fig. 10, which is an overlay, the URL also triggers another overlay to appear on the content page (another complementary channel or related URL or content, by its very nature, the bi-directional nature of the network, denotes that the user device in Houghton allows for entering preferences, transmitting those preferences and receiving contents in accordance. This reads squarely on the description of an EPG (which is an integral part of the Houghton system), where a user views content (an EPG listing), enters preferences (selects a channel), the selection is transmitted and the user is able to view the content selected (the contents in accordance are received) (see Houghton, col. 2, l. 55-col. 3, l. 28).

*With respect to the argument that Houghton does not teach overlays selected by a user from a list of overlays prior to display.* This is inaccurate; of course, Houghton teaches selection of overlays (see Houghton, col. 5, ll. 1-10, which also notes the bi-directional nature of the Houghton interface, it requests a URL (definitely, the request goes upstream to provider) and then the user receives content (definitely, the response goes downstream to user)--the epitome of bi-directional); the overlays are selected from a list of overlays (note Houghton, col. 7, l. 65-col. 8, l. 35, fig. 8 and 9 show overlaid links and windows

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on a backdrop, these overlays including URLs are listed for user selection, once selected, they result in further display of an overlay, also as noted, the user may choose the URLs displayed (from a listing, otherwise only a single URL would be available for choosing) for future choosing of overlays to display); and the choice of overlays (URLs, hotlinks, Windows) is made prior to display by the user-that is the nature of the featured tuning)). The list of complementary TV channels or URLs is selected by the user (see Houghton, col. 9, ll. 23-28, user sets up the mapping which is the complementary data (including URLs, see Houghton, col. 10, ll. 50-56).

As to claim 2, Houghton discloses the system of claim 1, wherein said bi-directional communication data network is the Internet, said broadcast source is a television programming source, and said broadcast-based client-side device includes a set top box that is coupled to the Internet and to said broadcast source (see Houghton col. 2, ll. 30-33 for network = internet, see col. 2, ll. 24-28 and fig. 7 for TV programming, see col. 7, ll. 12-20 for STB coupled to internet and broadcast source).

As to claim 8, Houghton discloses the system of claim 1, wherein said user interface is populated with server data from said server over said data network, said server data relating to said plurality of user preferences (see Houghton, col. 7, ll. 27-43 and fig. 8, for server data).

As to claim 9, Houghton discloses the system of claim 8, wherein said server is further to: generate said non-broadcast content using said plurality of user preferences entered using said user interface (see Houghton, col. 6, ll. 56-65); receive a request from said broadcast-based client-side device (see Houghton, col. 1, ll. 58-65, selection of user preferred URL web link *is* a request to host computer);

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and transmit said non-broadcast content to said broadcast-based client-side device in response to said request (see Houghton, col. 7, ll. 37-44 and fig. 7).

As to claims 11 and 21, except for the recitation of “method” and “computer program product”, respectively, they are analyzed similar to claims 1 and 9 (see Houghton, abstract for method).

As to claims 12 and 22, they are similar to claim 2; therefore, claims 12 and 22 are analyzed similar to claim 2 (see above).

As to claims 18, 19, they are analyzed similar to claims 8, 9, respectively.

As to claims 28, 29, they are analyzed similar to claims 8, 9, respectively.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-4, 7, 13-14, 17, 23-24, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houghton et al. (US 6 757 707 B1) in view of Boston et al. (US 2004/0091236 A1).

As to claim 3, Houghton discloses the system of claim 1, wherein said user interface is used to enter said plurality of user preferences; however, Houghton is unclear on a user account accessed prior.

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Boston, who discloses a preference entry system for video, does teach a user interface used to access a user account prior to entering said user account to be used to associate said plurality of user preferences with a particular user (see Boston, [0060] and fig. 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the internet TV system of Houghton with the preference entry system of Boston so to make preference selection secure for multiple users of a system (see Boston, [0005-0007]).

As to claim 4, Houghton discloses the system of claim 3, wherein said plurality of user preferences relate to one or more of games, personals, fantasy sports, movie content, music content, video on demand, content overlays, auctions and photos (see Houghton, col. 7 ll. 50-58 for user preferred URLs related to movie content).

As to claim 7, Houghton discloses the system of claim 1 and Boston discloses the preference entry system (which composes claim 3), wherein said user interface includes one or more drop down menus usable to enter said plurality of user preferences (see Boston for drop down menus of preference setup, fig. 6).

As to claim 13 and 23, they are analyzed similar to claim 3.

As to claims 14 and 24, they are analyzed similar to claim 4.

As to claim 17 and 27, they are analyzed similar to claim 7.

10. Claims 5-6, 15-16, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houghton et al. (US 6 757 707 B1) in view of Boston et al. (US 2004/0091236 A1) in further view of Nobakht et al (US 6 813 639 B2).

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As to claim 5, Houghton discloses the system of claim 1 and Boston discloses the preference entry system (which composes claim 3), wherein said user interface is to include a plurality of hyperlinks.

Houghton is unclear that the links are usable to access a plurality of submenus; however, Nobakht, who discloses a method for establishing internet access, does teach links that are usable to access a plurality of submenus, said submenus usable to enter said plurality of user preferences (see Nobakht, figs. 9/10 for hyperlinks (e.g., within 910B-2) to submenus to enter prefer (e.g., of 3101, choose to view business news).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the internet TV system of Houghton with the internet access method of Nobakht allows easy channel-based internet access for viewers (see Nobakht, col. 2, line 57-col. 3, line 6).

As to claim 6, Houghton discloses the system of claim 1 and Boston discloses the preference entry system (which composes claim 3) and Nobakht teaches the access to submenus of claim 5, wherein said plurality of submenus relate to one or more of games, personals, fantasy sports, movie content, music content, video on demand, content overlays, auctions and photos (see Nobakht, figs. 9/10 for submenu related to entertainment (0000) or hobby (3801) which could encompass any of games, personals, fantasy sports, movie content, music content, video on demand, content overlays, auctions and photos).

As to claims 15 and 25 they are analyzed similar to claim 5.

As to claims 16 and 26 they are analyzed similar to claim 6.

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***Inquiries***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul J. Graham whose telephone number is 571-270-1705. The examiner can normally be reached on Monday-Friday 8:00a-5:00p EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pjg  
9/9/2008

/Vivek Srivastava/  
Supervisory Patent Examiner, Art Unit 2623